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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,003	03/27/2001	Raymond F. Ratcliff III	40017660-0002	2031

47604 7590 11/01/2006

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EXAMINER	
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ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/818,003
Filing Date: March 27, 2001
Appellant(s): RATCLIFF, RAYMOND F.

Dale S. Lazar
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/3/06 appealing from the Office action mailed 12/20/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

Claims 42 – 44 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6515988	Eldridge et al.	2-03
6229139	Neukermans et al.	5-01
6765559	Hayakawa Keissuke	7-04
6707581	Browning, Denton R.	3-04
6771568	Hochendoner, David	8-04

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims **1 - 52** are pending. Independent claims are **1, 12, 16, 22, 30, 34, 38, 42, 45, 47, 48, 49.** These rejections are set forth in prior Office Action, Paper No. 10068909\20051021 and reproduced for convenient.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims **42-44** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). ..... When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. § 101. (See **Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility on** page 51)

Claims 42-44 which indicate carrier wave are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 18, line 7, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., RAMs, EPROMs, EEPROMs,) and intangible embodiments (e.g., a carrier wave such as an electronic signal transferred). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 103

4. **Claims 1, 2, 7 - 9, 12 - 19, 21 - 23, 30, 31, 33 - 42, 44, 45 - 52** are rejected under 35 U.S.C.103(a) as being unpatentable over **Eldridge et al.** (US Patent No. 6,515,988) and in view of **Nuekermans et al.** (US Patent No. 6,229,139).

Regarding Claim 1, Eldridge discloses a method for sending information to a data processing apparatus for identification of a document having the information using a handheld device capable of communicating with the data processing apparatus, the handheld device having a memory, the method comprising:

a) providing the document; (see Eldridge col. 1, lines 28-35)

c) storing the captured information in the memory of the handheld device as document data; (see Eldridge col. 1, lines 50-53)

d) establishing a communications path between the handheld device and the data processing apparatus; (see Eldridge col. 4, line 64 - col. 5, line 3)

e) retrieving the document data from the memory of the handheld device; (see Eldridge col. 5, lines 23-28) and

f) sending the retrieved document data from the handheld device to the data processing apparatus through the communications path for identification of the document. (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

b) Eldridge discloses usage of tokens (i.e. identification information or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans

discloses handheld device with attached scanner wherein usage for capturing the information from the document, wherein the information comprises actual data from the document; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6: "*... A document scanner in accordance with the present invention provides the mobile user with very light weight, high speed, high resolution, low power document scanning capability in any environment ...*")

Regarding Claims 2, 23, Eldridge discloses the method of claims 1, 22 wherein the document is an electronic document. (see Eldridge col. 1, lines 32-35; col. 9, lines 24-29)

Regarding Claims 7, 35, 46, Eldridge discloses the method of claims 1, 34, 35 wherein the handheld device is a cellular phone. (see Eldridge col. 5, lines 35-40)

Regarding Claims 8, 36, Eldridge discloses the method of claims 1, 34 wherein the

handheld device is a personal digital assistant ("PDA"). (see Eldridge col. 5, lines 23-28)

Regarding Claims 9, 37, Eldridge discloses the method of claims 1, 34 wherein the handheld device is a watch. (see Eldridge col. 1, lines 23-28)

Regarding Claim 12, Eldridge discloses in a data processing apparatus, a method for identifying a document for sharing with a recipient, the method comprising:

a) providing a plurality of reference documents, each reference document having reference data stored in a memory; (see Eldridge col. 1, lines 28-35)

c) extracting at least a portion of the received document data as scanning data; (see Eldridge col. 5, lines 19-23)

d) retrieving the reference data from the memory; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

e) comparing the scanning data with the reference data; and selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document. (see Eldridge col. 2, lines 26-28)

b) Eldridge discloses usage of tokens (i.e. identification information or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans

discloses handheld device with attached scanner wherein usage for receiving, from a handheld device, document data associated with one of the reference documents, wherein the document data comprises actual data from the document; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claims 13, 39, 50, 51, Eldridge discloses the method of claims 12, 16, 38 wherein the scanning data extracted from the received document data includes digital text data identifying a name of the one reference document. (see Eldridge col. 2, lines 36-39)

Regarding Claims 14, 40, Eldridge discloses the method of claims 12, 38 wherein the scanning data extracted from the received document data includes digital text data identifying an author of the one reference document. (see Eldridge col. 2, lines 36-39)

Regarding Claims 15, 41, Eldridge discloses the method of claims 12, 38 wherein the scanning data extracted from the received document data includes digital text data

identifying a publication date of the one reference document. (see Eldridge col. 2, lines 36-39)

Regarding Claims 16, 48, Eldridge discloses in a data processing apparatus, a method for identifying a document and sharing the identified document with a recipient, the data processing apparatus coupled to a data network, the method comprising:

a) providing a plurality of reference documents, each reference document having associated reference data stored in a memory; (see Eldridge col. 1, lines 28-35)

c) extracting at least a portion of the captured information as scanning data; (see Eldridge col. 5, lines 19-23)

d) retrieving the reference data from the memory; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

e) comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference documents, the one reference document as the identified document; (see Eldridge col. 2, lines 26-28) and

f) sending, using the address information, the selected document to the receiving address of the recipient. (see Eldridge col. 5, lines 14-17)

b) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses

receiving, from a handheld device in communication with the data processing apparatus, information captured from a source document by the handheld device, wherein the document data comprises actual data from the document and address information identifying a receiving address for the recipient; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 17, Eldridge discloses the method of claim 16 wherein the scanning data extracted from the received document data includes digital text data identifying a name of the source document. (see Eldridge col. 2, lines 36-39)

Regarding Claim 18, Eldridge discloses the method of claim 16 wherein the scanning data extracted from the received document data includes digital text data identifying an author of the source document. (see Eldridge col. 2, lines 36-39)

Regarding Claim 19, Eldridge discloses the method of claim 16 wherein the scanning data extracted from the received document data includes digital text data identifying a

publication date of the source document. (see Eldridge col. 2, lines 36-39)

Regarding Claim 21, Eldridge discloses the method of claim 16 wherein sending the selected document includes: sending the selected document to the receiving address via facsimile transmission. (see Eldridge col. 2, lines 8-10)

Regarding Claim 22, Eldridge discloses a method for sharing with a recipient a document having information using a handheld device having a memory and capable of communicating with a data processing apparatus in communication with a data network, the method comprising:

b) storing the captured information in the memory of the handheld device; (see Eldridge col. 1, lines 50-53)

c) providing, to the handheld device, address information identifying a receiving address for the recipient; (see Eldridge col. 6, lines 48-53)

d) storing, in the memory of the handheld device, the address information; (see Eldridge col. 6, lines 48-53)

e) establishing a communications path between the handheld device and the data processing apparatus; (see Eldridge col. 4, line 64 col. 5, line 3)

f) sending the captured information and the address information from the handheld device to the data processing apparatus via the communications path; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

g) receiving, by the data processing apparatus, the captured information and the address information from the handheld device; (see Eldridge col. 5,lines 23-28)

h) extracting at least a portion of the captured information as scanning data; (see Eldridge col. 5, lines 19-23)

i) providing a plurality of reference documents, each reference document having reference data stored in a reference memory; (see Eldridge col. 1, lines 28-35)

j) retrieving the reference data from the reference memory; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

k) comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document; (see Eldridge col. 2, lines 26-28) and

l) sending, using the address information, the selected document to the receiving address of the recipient. (see Eldridge col. 5, lines 14-17)

a) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for capturing the information from the document using the handheld device, wherein the document data comprises actual data from the document; (see Nuekermans col. 3, lines

51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 30, Eldridge discloses a data processing apparatus for identifying one of a plurality of reference documents for sharing with a recipient in communication with a data network, each reference document having reference data, from information received from a handheld device in communication with the data processing apparatus, the data processing apparatus coupled to the data network, the apparatus comprising:

a) a memory in which a plurality of instructions are stored; (see Eldridge col. 5, lines 5-10) and

b) a processor coupled to the memory (see Eldridge col. 5, lines 5-10) and coupled to:

(i) access the reference data in a storage medium, and

(ii) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However,

Nuekermans discloses handheld device with attached scanner wherein usage for receive the information from the handheld device, wherein the document data comprises actual data from the document, (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage) the processor capable of executing the instructions in the memory, execution of the instructions causing a plurality of steps to be performed including:

a) extracting at least a portion of the information received from the handheld device as scanning data, (see Eldridge col. 5, lines 19-23)

b) comparing the scanning data with the reference data, and selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document. (see Eldridge col. 2, lines 26-28)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 31, Eldridge discloses the data processing apparatus of claim 30, execution of the instructions by the processor causing further steps to be performed, namely:

a) establishing a communications path between the data processing apparatus and the recipient via the data network, (see Eldridge col. 4, line 64 - col. 5, line 3) and

b) sending, using the address information, the selected document to the receiving address of the recipient via the communications path. (see Eldridge col. 5, lines 14-17)

Regarding Claim 33, Eldridge discloses the method of claim 31 wherein sending the selected document includes: sending the selected document to the receiving address via facsimile transmission. (see Eldridge col. 2, lines 8-10)

Regarding Claim 34, Eldridge discloses a system for identifying one of a plurality of reference documents, each reference document having associated reference data, for sharing the identified document with a recipient, the system comprising:

a) a data processing apparatus in communication with a data network; (see Eldridge col. 1, lines 28-35) and

b) a handheld device having a memory and capable of:

i) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for capturing the information from the document, wherein the document data

comprises actual data from the document, (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

ii) storing the captured information in the memory, (see Eldridge col. 1, lines 50-53)

iii) storing, in the memory, address information identifying a receiving address for the recipient, (see Eldridge col. 1, lines 50-64; col. 2, lines 26-28)

iv) establishing a communications path with the data processing apparatus, (see Eldridge col. 4, line 64 - col. 5, line 3) and

v) sending the captured information and the address information from the handheld device to the data processing apparatus via the communications path; (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

the data processing apparatus capable of:

a) receiving the captured information and the address information from the handheld device, (see Eldridge col. 1, lines 50-64; col. 3, lines 11-12)

b) extracting at least a portion of the captured information as scanning data, (see Eldridge col. 5, lines 19-23)

c) accessing the reference data, (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

d) comparing the scanning data with the reference data, selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference documents, the one reference document as the identified document, (see Eldridge col. 2, lines 26-28)

e) establishing a communications path between the data processing apparatus and the recipient via the data network, (see Eldridge col. 4, lines 64 - col. 5, line 3) and

f) sending, using the address information, the selected document to the receiving address of the recipient via the communications path. (see Eldridge col. 5, lines 14-17)

Regarding Claims 38, 42, Eldridge discloses a processor readable storage medium having processor readable program code such that, when executed by a processor in a data processing apparatus, performs a method for identifying one of a plurality of reference documents for sharing with a recipient, each reference document having reference data, from information received by the data processing apparatus from a handheld device in communication with the data processing apparatus, the method comprising:

b) extracting at least a portion of the information received from the handheld device as address information identifying a receiving address for the recipient; (see Eldridge col. 1, lines 50-64; col. 2, lines 26-28)

c) comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data of one of the reference documents, the one reference document as the identified document; (see Eldridge col. 2, lines 26-28) and

e) sending, using the address information, the selected document to the receiving address of the recipient. (see Eldridge col. 5, lines 14-17)

a) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for extracting at least a portion of the information received from the handheld device as scanning data, wherein the document data comprises actual data from the document; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in

order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 44, Eldridge discloses the method of claim 42 wherein sending the selected document includes: sending the selected document to the receiving address via facsimile transmission. (see Eldridge col. 2, lines 8-10)

Regarding Claim 45, Eldridge discloses a method for sending information to a data processing apparatus for identification of an item using a handheld device capable of communication with the data processing apparatus, the handheld device having a memory, the method comprising:

b) storing the captured information in the memory of the handheld device as data; (see Eldridge col. 1, lines 50-53)

c) establishing a communications path between the handheld device and the data processing apparatus; (see Eldridge col. 4, line 64 - col. 5, line 3)

d) retrieving the captured information from the memory of the handheld device; (see Eldridge col. 5, lines 23-28) and

e) sending the retrieved data from the handheld device to the data processing apparatus through the communications path for identification of the item. (see Eldridge col. 1, lines 64-67; col. 3, lines 11-12)

a) Eldridge discloses usage of tokens (i.e. identifier or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains

whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for capturing information from the item, wherein the information comprises actual data from the item; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 47, Eldridge discloses a method, comprising:

a) providing a plurality of reference items, each reference item having associated reference data stored in a memory; (see Eldridge col. 1, lines 28-35)

c) extracting at least a portion of the captured information as scanning data; (see Eldridge col. 5, lines 19-23)

d) comparing the scanning data with the reference data; selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference items, the one reference item as the identified item; (see Eldridge col. 2, lines 26-28) and

f) sending, using the address information, the identified item to the receiving address of the recipient. (see Eldridge col. 5, lines 14-17)

b) Eldridge discloses usage of tokens (i.e. identification information or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for receiving, from a handheld device in communication with the data processing apparatus, information captured from an item by the handheld device, wherein the information comprises actual data from the item, and address information identifying a receiving address for the recipient; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans. One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claims 48, 49, Eldridge discloses a method, comprising:

a) providing a plurality of reference documents, each reference document having associated reference data stored in a memory; (see Eldridge col. 1, lines 28-35)

c) extracting at least a portion of the captured information as scanning data; (see Eldridge col. 5, lines 19-23)

d) comparing the scanning data with reference data; selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference documents, the one reference document as the identified document. (see Eldridge col. 2, lines 26-28)

b) Eldridge discloses usage of tokens (i.e. identification information or subset of data from document) for identification. (see Eldridge col. 2, lines 27-29: token contains whatever information necessary to identify document) Eldridge does not disclose the capture of actual data from document. However, Nuekermans discloses handheld device with attached scanner wherein usage for receiving, from a handheld device in communication with the data processing apparatus, information captured from a document by the handheld device, wherein the information comprises actual data from the document; (see Nuekermans col. 3, lines 51-56; col. 2, line 62 - col. 4, line 2: handheld device with scanner and memory for scanned information storage)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to scan a document and generate digital data which can be used for comparison identification as taught by Nuekermans.

One of ordinary skill in the art would be motivated to employ Nuekermans in order to enable lightweight, high speed, high resolution document scanning capabilities. (see Nuekermans col. 4, lines 2-6)

Regarding Claim 51, 52, Eldridge discloses the method of claims 16, 38 wherein the scanning data extracted from the received document data includes digital text data identifying a name of a publication in which the source document appears. (see Eldridge col. 8, lines 22-26)

5. **Claims 3 - 6, 24 - 27** are rejected under 35 U.S.C.103 (a) as being unpatentable over by **Eldridge-Nuekermans** and further in view of **Hayakawa** (US Patent No. 6,765,559)

Eldridge discloses an electronic document server with a network accessible repository (see Eldridge col. 9, lines 24-29: *"... request for a document held in an electronic repository ... stored on a remote file server 52 (which may be in a different building or in a different country)"*). Eldridge does not disclose the capability to access and process specific physical documents such as a newspaper, magazine, or other periodicals publications. However, Hayakawa discloses the capability to access and process specific physical documents such as a newspapers, magazines, or other periodical publications.

Regarding Claims 3, 24, Hayakawa discloses the method of claims 1, 22 wherein the document is a physical document. (see Hayakawa col. 1, lines 43-47) It would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to include the capability to access and process specific physical documents such as a newspaper, magazine, or other periodical publication. One would have been motivated to substitute the capabilities in Hayakawa in order to extend and enhance the processing capabilities of the document processing system.

Regarding Claims 4, 25, Hayakawa discloses the method of claims 3, 24 wherein the physical document is a periodical article. (see Hayakawa col. 1, lines 14-19) Referring to claims 4, 25, claims 4, 25 encompass the same scope of the invention as that of the claims 3, 24. Therefore, claims 4, 25 are rejected for the same reason and motivation as the claims 3, 24.

Regarding Claims 5, 26, Hayakawa discloses the method of claims 3, 24 wherein the physical document is a newspaper article. (see Hayakawa col. 1, lines 14-19) Referring to claims 5, 26, claims 5, 26 encompass the same scope of the invention as that of the claims 3, 24. Therefore, claims 5, 26 are rejected for the same reason and motivation as the claims 3, 24.

Regarding Claims 6, 27, Hayakawa discloses the method of claims 3, 24 wherein the physical document is a magazine article. (see Hayakawa col. 1, lines 14-19) Referring to claims 6, 27, claims 6, 27 encompass the same scope of the invention as that of the claims 3, 24. Therefore, claims 6, 27 are rejected for the same reason and motivation

as the claims 3, 24.

6. **Claims 10, 20, 28, 32, 43** are rejected under 35 U.S.C.103 (a) as being unpatentable over by **Eldridge-Nuekermans** and further in view of **Browning** (US Patent No. 6,707,781)

Eldridge discloses a server system with a network accessible repository for electronic documents. (see Eldridge col. 1, lines 23-28: *"This system can include any number workstations, file servers, ... coupled in a network, and a number of portable devices (e.g. handheld or wristwatch computer) carried by users ...."*) Eldridge does not specifically disclose the capability to scan a physical document (generate an image), decode this into a digital data representation and place it into data storage. Eldridge does not disclose the capability to process a digital document by the attachment of this electronic document to an e-mail message. However, Browning does disclose the capability to scan a physical document (i.e. generate an image), decode it into digital data and place the final digital representation into system storage. Further, Browning discloses the capability to process a electronic digital document and attach it to an e-mail message.

Regarding Claims 10, 28, Browning discloses the method of claim 1 wherein: capturing the information includes:

a) scanning the document to generate scanned information, and converting the scanned information to digital text data; (see Browning col. 1, lines 50-53) and

b) wherein storing the captured information includes storing the digital text data. (see Browning col. 2, lines 16-19)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge with the capability to scan a physical document (i.e. generate an image), decode it into digital data and place it into storage. One would have been motivated to substitute the capabilities in Browning in order to enhance and integrate the capabilities of processing physical documents in the document server system.

Regarding Claims 20, 32, 43, Browning discloses the method of claims 16, 31 wherein sending the selected document includes: attaching the selected document to an e-mail message, and sending the e-mail message to the receiving address via the data network. (see Browning col. 2, lines 9-15)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge with the capability to process an electronic document by its attachment to an e-mail message before network transmission. One would have been motivated to substitute the capabilities in Browning in order to include and enhance the techniques of electronic messaging within the document management system.

7. **Claims 11, 29** are rejected under 35 U.S.C.103(a) as being unpatentable over by **Eldridge-Nuekermans** and further in view of **Hochendoner** (US Patent No. 6,771,568).

Eldridge discloses a document server with a network accessible repository for electronic documents. (see Eldridge col. 9, lines 24-29: "*... request for a document held in an electronic repository ...stored on a remote file server 52 (which may be in a different building or in a different country),*"). Eldridge does not specifically disclose the capability to input an audio analog signal message, decode this message into digital data and its placement into data storage. However, Hochendoner does specifically disclose the capability to input an audio analog signal message, decode this message into audio digital data and its placement into data storage.

Regarding Claims 11, 29, Hochendoner discloses the method of claim 1 wherein: capturing the information includes:

a) providing the information as spoken audio, (see Hochendoner col. 3, lines 34-36) and converting the spoken audio to a digital audio signal; and

b) wherein storing the captured information includes storing the digital audio signal. (see Hochendoner col. 3, lines 23-26)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge with the capability to input an audio analog signal message, decode this message into digital data and its placement into data storage. One would have been motivated to substitute

the capabilities in Hochendoner for the integration of multimedia content into the data processing apparatus in order to fulfill a need to receive audio signal from any type of handheld devices.

(10) Response to Argument

A: Claims **1, 2, 7 9, 12 19, 21 23, 30, 31, 33 41** and **45 52** are unpatentable under 35 U.S.C. § 103(a) over **Eldridge et al.** (U.S. Patent No. **6,515,988**) in view of **Neukermans et al.** (U.S. Patent No. **6,229,139**). *(See Appeal Remarks Page 8, Lines 3-5)*

A.1: Claims **1, 2, 7 9, 12 19, 45 and 46**

Applicant argues that within the referenced prior art *"... There is no suggestion in Eldridge et al. to replace the tokens with actual document data and there is no suggestion in Eldridge et al. to add actual document data to the tokens, as the Examiner suggested. In fact, Eldridge et al. clearly states that, "documents are effectively distributed between devices by transmission of document URLs, rather than the lengthy document itself." (emphasis added), ... " (see Appeal Remarks Page 10, Lines 15-19 and Page 11, Lines 16-22)*

As to Point A.1:

There was no indication that the stated tokens indicated in Eldridge are to be replaced by *"document data"*. The Eldridge and Neukermans combination merely adds

the scanned *"document data"* and conversion into digital data feature from Neukermans to Eldridge. Eldridge's token will include the document data, which is an additional identification parameter within the token, and is transmitted to a document server in order to complete one of the principal functions of Applicant's Invention, which is document identification.

The Eldridge token is a collection of identification parameters to specify a particular document. By applicant's own admission the selected document data, which is data scanned from an actual document, is used for identification purposes.

A document can be identified merely by a passage from that document. *"Call me Ishmael"* from Moby Dick, or *"It is a far, far better thing that I do, than I have ever done"* from A Tale of Two Cities. Mention these passage and any knowledgeable individual can identify the document. Clearly, a passage or a set of document data (i.e. actual data from a document) can be utilized to identify a document. To utilize this concept on a larger scale using IT resources at the time of applicant's invention would be considered obvious to one skilled in the art.

Therefore, it would be obvious to consider the scanned document data being utilized for identification purposes and as an additional identification parameter as disclosed by Eldridge. (see Eldridge col. 2, lines 33-39: identification parameters, specify the document) Eldridge and Neukermans combination discloses a handheld scanner, which is usable as an attached or integrated device with the capability to capture (i.e. scan) document data and store (i.e. an utilized as a document identifier utilized by Eldridge). Eldridge still transmits a token for document identification

purposes. There is no instance in Eldridge where the entire document is transmitted for identification purposes.

Neukermans discloses the capability to scan a document and the capability for the conversion of image data into digital data. (see Neukermans col. 1, lines 38-40; col. 1, line 43-46) Eldridge discloses the usage of a digital representation of information as an identification parameter. The Neukermans handheld scanner can be directly connected to the handheld device. Therefore, the transmission of scanned digital data between the handheld device and the scanner does not require any network communications path (see Appeal Remarks Page 9, Lines 32-33) only a direct connection communications path. (see Neukermans col. 3, lines 51-53) The Eldridge prior art already discloses the utilization of network communications to access the document servers.

The proposed combination would not destroy the Eldridge prior art. (see Appeal Remarks Page 11, Lines 4-6) It would be advantageous by adding a new and very useful feature to the Eldridge prior art. Adding an additional identification parameter would only enhanced the capabilities of the Eldridge prior art.

The purpose of Eldridge is to process document identification data, and actual document data can be document identification data and is therefore eligible for usage by Eldridge. It has been established that actual data from a document can be used for identification purposes and that this fact is obvious to anyone skilled in the art.

Once the document data has been designated for document identification data, it can be transferred between network-connected systems for identification purposes.

(see Appeal Remarks Page 13, Lines 11-12)

Examiner has clearly demonstrated the validity of the rejections for Claims **1 - 2, 7 - 9, 12 - 19, 45 and 46**.

A.2: Claims **12, 13, 30, 48 and 49**

Applicant argues that the referenced prior art does not disclose *" ... receiving from a handheld device, document data associated with one of the reference documents, wherein the document data comprises actual data from the document... " (see Appeal Remarks Page 14, Lines 32-33)*

As to Point A.2:

Eldridge and Neukermans disclose receiving from a handheld device, document data, wherein the document data comprises actual data from the document. (see Neukermans col. 3, lines 51-56; col. 2, line 62 - col. 3, line 3)
Eldridge discloses the identification of a document at document server. The reason for the comparison function for the scanned document identification data or is to identify the document at a document server. (see Appeal Remarks Page 14, Lines 9-10)

Neukermans is not required to disclose comparing scanning data (see Appeal Remarks Page 14, Line 32 - Page 15, Line 4) The Office Action stated for claim 12(e) that Eldridge disclose the comparison function which is equivalent to identification of a document. The results of the comparison identify a particular document. The Eldridge and Neukermans combination performs the required capture of scanning data and subsequent comparison.

In addition, Eldridge discloses a plurality of documents and that each of the documents has reference information stored in a memory. The associated referenced information is the designated token. (see Eldridge col. 10, lines 25-27; col. 2, lines 10-11: plurality of documents, token utilized as document identification)

Examiner has clearly demonstrated the validity of the rejections for Claims **12, 13, 30, 48 and 49**.

A.3: Claim **14**

Applicant argues that the referenced prior art does not disclose "*... the scanning data extracted from the received document data includes digital text data identifying an author of the one reference document ...*". *(see Appeal Remarks Page 16, Lines 2-4)*

As to Point A.3:

The Eldridge prior art disclose parameters utilized to specify a particular document. The author of a document is a parameter utilized to identify a particular document. (see Eldridge col. 2, lines 33-39: document specific identification information) As stated above, the Eldridge and Neukermans combination disclosed the capability to scan document data, convert to digital data, and generate document identification information for usage by Eldridge to identify a document.

Examiner has clearly demonstrated the validity of the rejection for Claim **14**.

A.4: Claim **15**

Applicant argues that the referenced prior art does not disclose *" ... the scanning data extracted from the received document data includes digital text data identifying a publication date of the one reference document ... ". (see Appeal Remarks Page 16, Lines 19-21)*

As to Point A.4:

The Eldridge prior art disclose parameters utilized to specify a particular document. The publication date of a document is a parameter utilized to identify a particular document. (see Eldridge col. 2, lines 33-39: document specific identification information) As stated above, the Eldridge and Neukermans combination disclosed the capability to scan document data, convert to digital data, and generate document identification information for usage by Eldridge to identify a document.

Examiner has clearly demonstrated the validity of the rejection for Claim **15**.

A.5: Claim **50**

Applicant argues that the referenced prior art does not disclose *" ... the scanning data extracted from the received document data includes digital text data identifying a name of a publication in which the one reference document appears. ... ". (see Appeal Remarks Page 16, Lines 29-31)*

As to Point A.5:

The Eldridge prior art disclose parameters utilized to specify a particular document. The name of a publication of a document is a parameter utilized to identify a

particular document. (see Eldridge col. 2, lines 33-39: document specific identification information) As stated above, the Eldridge and Neukermans combination discloses the capability to scan document data, convert to digital data, and generate document identification information for usage by Eldridge to identify a document.

Examiner has clearly demonstrated the validity of the rejection for Claim **50**.

A.6: Claim **31**

Applicant argues that the referenced prior art does not disclose *"... sending, using the address information, the selected document to the receiving address of the recipient via the communication path, ... ". (see Appeal Remarks Page 17, Lines 9-10)*

As to Point A.6:

Eldridge discloses the transmission of a document over a network communications path such as the Internet. An addressing scheme must be utilized in order to transfer any data (i.e. packets) over a communications path such as a network or the Internet. (see Eldridge col. 5, lines 14-28: document transfer, over Internet)

Applicant uses the term *"fetches"*, it is unclear how this term is used since the term does appear in the prior art. *(see Appeal Remarks Page 17, Line 13)*

Examiner has clearly demonstrated the validity of the rejection for Claim **31**.

A.7: Claim **33**

Applicant argues that the referenced prior art does not disclose " ... "sending the selected document to the receiving address via facsimile transmission." ... " (see Appeal Remarks Page 17, Lines 22-23)

As to Point A.7:

Eldridge disclose a fax as the communications method of transfer for a document to a destination system. (see Eldridge col. 5, lines 14-28: document transfer, fax capability)

Applicant uses the term *"fetches"*, it is unclear how this term is used since the term does appear in the prior art. *(see Appeal Remarks Page 17, Line 25)*

Examiner has clearly demonstrated the validity of the rejection for Claim **33**.

A.8: Claim **16, 17, 21, 38, 39 and 47**

Applicant argues that the referenced prior art does not disclose *" ... "comparing the scanning data with the reference data," ... "; " ... using scanned data and comparing the scanned data with reference data. ... "; " ... selecting, when the scanning data matches at least a portion of the reference data associated with one of the reference documents, the one reference document as the identified document ... "; " ... sending, using the address information, the selected document to the receiving address of the recipient ... " (see Appeal Remarks Page 18)*

As to Point A.8:

Each above stated limitation has been previously addressed and a clear and

concise explanation was given to justify the rejection of the claims limitations under 35 USC 103(a) in Office Action dated December 20, 2006.

Applicant uses the term "fetches", it is unclear how this term is used since the term does appear in the prior art. (see Appeal Remarks Page 19, Line 6)

Examiner has clearly demonstrated the validity of the rejections for Claims **16, 17, 21, 38, 39 and 47**.

A.9: Claim **18 and 40**

Applicant argues that the referenced prior art does not disclose *"... the scanning data extracted from the received document data include digital text data identifying an author of the one reference document ... ". (see Appeal Remarks Page 20, Lines 17-18)*

As to Point A.9:

The Eldridge prior art disclose parameters utilized to specify a particular document. The author of a document is a parameter utilized to identify a particular document. (see Eldridge col. 2, lines 33-39: document specific identification information) As stated above, the Eldridge and Neukermans combination disclosed the capability to scan document data and generate document identification information for usage by Eldridge to identify a document.

Examiner has clearly demonstrated the validity of the rejections for Claims **18 and 40**.

A.10: Claim **19 and 41**

Applicant argues that the referenced prior art does not disclose " ... *"the scanning data extracted from the received document data includes digital text data identifying a publication date of the one reference document ... ". (see Appeal Remarks Page 21, Lines 3-4)*

As to Point A.10:

The Eldridge prior art disclose parameters utilized to specify a particular document. The publication date of a document is a parameter utilized to identify a particular document. (see Eldridge col. 2, lines 33-39: document specific identification information) As stated above, the Eldridge and Neukermans combination disclosed the capability to scan document data and generate document identification information for usage by Eldridge to identify a document.

Examiner has clearly demonstrated the validity of the rejections for Claims **19 and 41**.

A.11: Claim **51 and 52**

Applicant argues that the referenced prior art does not disclose " ... *the scanning data extracted from the received document data includes digital text data identifying a name of a publication in which the one reference document appears. ... ". (see Appeal Remarks Page 21, Lines 15-16)*

As to Point A.11:

The Eldridge prior art disclose parameters utilized to specify a particular

document. The name of a publication of a document is a parameter utilized to identify a particular document. (see Eldridge col. 2, lines 33-39: document specific identification information) As stated above, the Eldridge and Neukermans combination disclosed the capability to scan document data and generate document identification information for usage by Eldridge to identify a document.

Examiner has clearly demonstrated the validity of the rejections for Claims **51 and 52**.

A.12: Claims **22, 23 and 34 - 36**

As to Point A.12:

Applicant argues that the referenced prior art does not disclose *" ... storing the captured information in the memory of the handheld device ... " (see Appeal Remarks Page 22, Lines 10-11)*

Eldridge and Neukermans prior art combination discloses the capability to store this "document data" within device memory for processing into a document identifier (i.e. equivalent to a token). (see Eldridge col. 2, lines 6-10: token utilized as a document identifier, transmitted between system for identification ; see Neukermans col. 3, lines 51-56; col. 3, lines 62-66: capture data from document utilizing scanning capabilities, subset of data from document)

The remaining arguments (Page 22, Lines 17-19; Page 22, Lines 25-26; Page 22, Line 22 - Page 23, Line 1; Page 23, Lines 10-11; Page 23, Lines 20-22) have been

disclosed in previous section of the Examiner's Answer.

Examiner has clearly demonstrated the validity of the rejections for Claims **22, 23 and 34 - 36**.

B: Claims **36 and 2427** are unpatentable under 35 U.S.C. § 103(a) over the combination of **Eldridge et al.** and **Neukermans et al.** and further in view of **Hayakawa** (U.S. Patent No. **6, 765,559**). *(See Appeal Remarks Page 8, Lines 6-8)*

B.1: Claims **3 6**

Applicant argues that the referenced prior art does not disclose *" ... providing the document; capturing the information from the document, wherein the information comprises actual data from the document; storing the captured information in the memory of the handheld device as document data; establishing a communications path between the handheld device and the data processing apparatus; retrieving the document data from the memory of the handheld device; and sending the retrieved document data from the handheld device to the data processing apparatus through the communications path for identification of the document," ... " (see Appeal Remarks Page 24, Lines 18-24)*

As to Point B.1:

As previously stated, the Eldridge and Neukermans prior art combination is utilized as the basis of the rejection for these claim limitations. The Hayakawa prior art is not

utilized as a basis for the rejection of these claims limitations. The Office Action dated December 20, 2005 clearly states the claim limitations the Hayakawa prior art was utilized for as a basis of rejection.

Examiner has clearly demonstrated the validity of the rejections for Claims **3 - 6**.

B.2: Claims **24 - 27**

Applicant argues that claim 10 depends from claim 1. *(see Appeal Remarks Page 26, Line 13)*

As to Point B.2:

As previously stated, the Eldridge and Neukermans prior art combination is utilized as the basis of the rejection for the claim 1 limitations. The Hayakawa prior art is not utilized as a basis for the rejection of the claim1 limitations. The Office Action dated December 20, 2005 clearly states the claim limitations the Hayakawa prior art was utilized for as a basis of rejection.

Examiner has clearly demonstrated the validity of the rejections for Claims **24 - 27**.

C: Claims **10, 20, 28 and 32** are unpatentable under 35 U.S.C. § 103(a) over the combination of **Eldridge et al.** and **Neukermans et al.** and further in view of **Browning** (U.S. Patent No. **6,707,781**). *(See Appeal Remarks Page 8, Lines 9-11)*

C.1: Claim **10**

Applicant argues that the claim 10 depend from claim 1. *(see Appeal Remarks Page 26, Line 13)*

As to Point C.1:

As previously stated, the Eldridge and Neukermans prior art combination is utilized as the basis of the rejection for the claim 1 limitations. The Hayakawa prior art is not utilized as a basis for the rejection of the claim1 limitations, but it is used as a basis for the rejection of claim 20 limitations. The Office Action dated December 20, 2005 clearly states the claim limitations the Hayakawa prior art was utilized for as a basis of rejection.

Examiner has clearly demonstrated the validity of the rejection for Claim **10**.

C.2: Claim **20**

Applicant argues that the claim 20 depend from claim 16 *(see Appeal Remarks Page 27, Line 2), and does not disclose " ... process an electronic document by attaching the electronic document to an email message and sending the email message to the receiving address. (see Appeal remarks Page 27, Lines 14-15)*

As to Point C.2:

As previously stated, the Eldridge and Neukermans prior art combination is utilized as the basis of the rejection for the claim 16 limitations. The Browning prior art is not

utilized as a basis for the rejection of claim 16 limitations, but it is used as a basis for the rejection of claim 20 limitations. The Office Action dated December 20, 2005 clearly states the claim limitations the Browning prior art was utilized for as a basis of rejection. The Eldridge-Neukermans and Browning combination discloses the capability to utilize e-mail attachments for document transfer. (see Browning col. 2, lines 9-15: e-mail attachment)

Examiner has clearly demonstrated the validity of the rejection for Claim **20**.

C.3: Claim **28**

Applicant argues that the claim 28 depend from claim 22. *(see Appeal Remarks Page 27, Line 21)*

As to Point C.3:

As previously stated, the Eldridge and Neukermans prior art combination is utilized as the basis of the rejection for the claims 22 and 28 limitations. The Browning prior art is not utilized as a basis for the rejection of claim 22 limitations, but is used as a basis for the rejection of claim 28 limitations. The Office Action dated December 20, 2005 clearly states the claim limitations the Browning prior art was utilized for as a basis of rejection. The Eldridge-Neukermans and Browning combination discloses the capability to scan and convert image data into digital data. (see Browning col. 1, lines 50-53; col. 2, lines 16-19: scan, conversion to digital data)

Examiner has clearly demonstrated the validity of the rejection for

Claim **28**.

C.4: Claim **32**

Applicant argues that claim 32 depends from claim 30 (see Appeal Remarks Page 28, Line 8), and does not disclose *"... process an electronic document by attaching the electronic document to an email message and sending the email message to the receiving address. (see Appeal remarks Page 28, Lines 21-22)*

As to Point C.4:

As previously stated, the Eldridge and Neukermans prior art combination is utilized as the basis of the rejection for the claim 30 limitations. The Browning prior art is not utilized as a basis for the rejection of claim 30 limitations, but it is used as a basis for claim 32 limitations. The Office Action dated December 20, 2005 clearly states the claim limitations the Browning prior art was utilized for as a basis of rejection. The Eldridge-Neukermans and Browning combination discloses the capability to utilize e-mail attachments for document transfer. (see Browning col. 2, lines 9-15: e-mail attachment)

Examiner has clearly demonstrated the validity of the rejection for Claim **32**.

D: Claims **11 and 29** are unpatentable under 35 U.S.C. § 103(a) over the combination

of **Eldridge et al.** and **Neukermans et al.** and further in view of **Hochendoner** (U.S. Patent No. **6,771,568**). *(See Appeal Remarks Page 8, Lines 12-14)*

D.1: Claim **11**

Applicant argues that claim 11 depends from claim 1, and does not disclose " ... capability to input a spoken audio signal, convert the audio signal to a digital audio signal and store the digital audio signal. ... " (see Appeal Remarks Page 29, Lines 15-16)

As to Point D.1:

As previously stated, the Eldridge and Neukermans prior art combination is utilized as the basis of the rejection for the claim 1 limitations. The Hochendoner prior art is not utilized as a basis for the rejection of claim 1 limitations, but it is used as a basis for claim 11 limitations. The Office Action dated December 20, 2005 clearly states the claim limitations the Hochendoner prior art was utilized for as a basis of rejection. The Eldridge-Neukermans and Hochendoner combination discloses the capability for the conversion of an audio signal into digital format. (see Hochendoner col. 3, lines 34-36; col. 3, lines 23-26: audio signal conversion and storage)

Examiner has clearly demonstrated the validity of the rejection for Claim **11**.

D.2: Claim **29**

Applicant argues that claim 29 depends from claim 22, and does not disclose " ...

capability to input a spoken audio signal, convert the audio signal to a digital audio signal and store the digital audio signal. ... " (see Appeal Remarks Page 29, Lines 15-16)

As to Point D.2:

As previously stated, the Eldridge and Neukermans prior art combination is utilized as the basis of the rejection for the claim 22 limitations. The Hochendoner prior art is not utilized as a basis for the rejection of claim 22 limitations, but it is used as a basis for claim 29 limitations. The Office Action dated December 20, 2005 clearly states the claim limitations the Hochendoner prior art was utilized for as a basis of rejection. The Eldridge-Neukermans and Hochendoner combination discloses the capability for the conversion of an audio signal into digital format. (see Hochendoner col. 3, lines 34-36; col. 3, lines 23-26: audio signal conversion and storage)

Examiner has clearly demonstrated the validity of the rejection for Claim **29**.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, in response to applicant's arguments against the reference individually, one cannot show nonobviousness by attacking references individually

where rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner Response to Argument dated July 3, 2006

The Examiner's Rejection is proper given that the cited passages of **Eldridge (6,515,988), Neukermans (6,229,139), Hayakawa (6,765,559), Browning (6,707,781) and Hochendoner (6,771,568)** disclose the applicant's claimed invention. All arguments, claims limitations presented in the Appeal Remarks dated July 3, 2006 were previously addressed and properly rejected.

Conclusion

The referenced prior art discloses Applicant's Invention essentially as claimed. Applicant's invention claims a system for searching and sharing document information utilizing multiple handheld devices communicating over a network enabling access to multiple document servers, the user indicates a particular document based on a set of identification information, which can be actual information scanned from a document, and an indicated action is performed with the indicated document. The referenced prior art discloses, as cited, a network connected system consisting of multiple handheld devices and multiple servers, which enables the capability to find a particular document based on a set of identification information, which can be actual information scanned from the document, and an indicated action is performed using the

selected document. **This disclosure in the reference prior art is equivalent to applicant's claimed invention.**

The rejection for each independent and dependent claim includes a citation from the referenced prior art that discloses the basis for the rejection. Each obviousness combination clearly indicates, as a column and line range citation, the claim limitation the combined reference prior art teaches. In addition, a cited passage from the referenced prior art clearly indicates the motivation for the obviousness combination. **Each obviousness combination's disclosure is equivalent to the applicant's claimed invention.**

In conclusion, the examiner has considered the applicant's remarks concerning a system which finds a specific document within a network connected environment based on a set of identification information, and the selected document is processed by the server system. The remarks were not persuasive. All claims in Applicant's Invention have been rejected as anticipatory or obvious based on the referenced prior art.

After the additional analysis of the applicant's invention, remarks, and an additional search of the available prior art, it was determined that the current set of prior art consisting of **Eldridge (6,515,988), Neukermans (6,229,139), Hayakawa (6,765,559), Browning (6,707,781), and Hochendoner (6,771,568)** discloses the Applicant's Invention including disclosures in Appeal Remarks dated July 3, 2006.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

KHS
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Art Unit 2143

KHS
October 23, 2006

Conferees:

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